

Attorney Docket No.: DEX-0176
Inventors: Ali et al.
Serial No.: ~~09/787,844~~
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REMARKS

Claim 3 is pending in the instant application. Claim 3 has been rejected. Claim 3 has been amended. Support for these amendments is provided in the specification at page 3 and 6. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. New Matter Rejection

The Examiner has objected to the amendment filed May 13, 2004 as introducing new matter. Applicants disagree since both the specification and the Declaration make clear that the instant application claims the benefit of priority from the provisional application in which the subject matter was taught. Applicants' believe that this claim to priority makes clear Applicants' intentions that the teachings of this prior patent application be incorporated by reference into the instant application.

However, in an earnest effort to advance the prosecution of this case, Applicants request that the Sequence Listing filed

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May 13, 2004 be canceled and that the Sequence Listing filed April 3, 2001 be reinstated.

Withdrawal of this rejection is respectfully requested in light of the amendments to the Sequence Listing.

II. Rejection of Claim 3 under 35 U.S.C. 112, second paragraph

Claim 3 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner suggests that it is not clear what the metes and bounds are of the phrase "under stringent conditions".

Applicants respectfully disagree, as Applicants believe that the meaning of this phrase is understood by the skilled artisan.

However, in an earnest effort to advance the prosecution of this case, Applicants have amended the claims to remove this phrase.

Withdrawal of this rejection is therefore respectfully requested.

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**III. Rejection of Claim 3 under 35 U.S.C. 112, first paragraph
- Written Description**

Claim 3 has been rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner suggests that there is a lack of written description for Ovr107 comprising a polynucleotide which hybridizes under stringent conditions to the antisense sequence of SEQ ID NO:1.

Thus, while Applicants respectfully disagree with the Examiner, in an earnest effort to advance the prosecution of this case, claim 3 has been amended to remove the phrase "comprising a polynucleotide which hybridizes under stringent conditions to the antisense of SEQ ID NO:1." Instead, claim 3 has been amended in accordance with teachings at page 3 and 6 to state that Ovr107 comprises SEQ ID NO:1, a native mRNA encoded by the gene comprising SEQ ID NO:1, or a polynucleotide which, due to degeneracy in genetic coding comprises variations in nucleotide sequence as compared to SEQ ID NO:1, but which encodes the same protein. No new matter is added by this amendment.

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Withdrawal of this rejection under 35 U.S.C. 112, first paragraph, is respectfully requested in light of the amendments to claim 3.

IV. Rejection of Claim 3 under 35 U.S.C. 112, first paragraph - Enablement

Claim 3 has been rejected under 35 U.S.C. 112, first paragraph. The Examiner has acknowledged the specification to be enabling for detection in cells and tissue samples. However, the Examiner suggests that the specification does not reasonably provide enablement for bodily fluids. In particular, the Examiner suggests that while Table 2 at page 21-30 discloses higher expression of SEQ ID NO:1 in tissues from ovarian, lung, and endometrium, the specification does not teach whether the nucleic acid molecule is also detected in bodily fluids.

Thus, in an earnest effort to advance the prosecution of this case, Applicants are providing herewith a bar graph with results from quantitative PCR experiments which confirms that Ovr107 is detectable in a bodily fluid, namely blood. These experiments were performed in accordance with teachings in the

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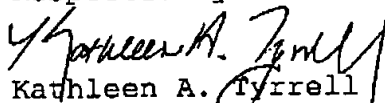
specification at page 19-20 which have been acknowledged by the Examiner to be enabling for detection in cells and tissue samples.

These data generated in accordance with methodologies set forth in the instant specification clearly demonstrate that there is no reason to doubt the objective truth of statements made in the specification that Ovr107 is detectable in bodily fluids. Thus, the instant specification clearly meets the enablement requirements of 35 U.S.C. 112, first paragraph, and withdrawal of this rejection is respectfully requested.

IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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Date: November 29, 2004

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